

Application No.: 09/889,167

REMARKS

Claim 14 stands rejected under 35 U.S.C. § 112, second paragraph because the Examiner alleges that the claimed language is “confused and unclear if and how the information or record or database is recognizable or analyzed by a human.” This rejection is respectfully traversed for the following reasons. Indeed, it is not clear exactly what the Examiner is objecting to. Regarding the Examiner’s inquiry as to “if” the information is recognizable by a human, claim 14 expressly states “wherein the identification information is recognizable by a human” rendering the Examiner’s confusion regarding “if” unwarranted. Further, it is submitted that the Examiner’s other inquiry as to “how,” etc., the information is recognizable by a human is directed to claim *scope* rather than claim *definiteness*. As set forth in MPEP § 2173.04, claim breadth is not indefiniteness, whereby the claim need not recite the particular manner of “how” information is recognizable by a human. In view of the foregoing, it is respectfully submitted that claim 14 is definite as currently recited; therefore, it is respectfully requested that this rejection be withdrawn.

Claims 6, 8, 14 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over JP ‘834 in view of Nakatsuka et al.. This rejection is respectfully traversed for the following reasons.

The Examiner relies on paragraph [0020] of JP ‘834 (*see* beginning on line 7 from the bottom of page 3 of the outstanding Office Action) as allegedly disclosing an IC carrying the claimed identification information (i.e., information indicating presence of lead, type/composition of solder, kind of soldered parts, and material of article). However, it is respectfully submitted that the alleged IC does NOT provide the information recited in the pending claims, but is simply a Timer IC recording such things as the date of manufacture, etc.,

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to know the actual usage time. The alleged IC certainly does not record the absence/presence of lead, etc., and indeed does not carry the claimed information about the solder (e.g., type and composition of solder, etc.). JP '834 merely discloses a simple bar code to indicate information regarding heavy metals, whereas the present invention can use an IC to record a much larger depth of information which can be freely and easily changed.

The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard for establishing obviousness under § 103:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (emphasis added) (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in the pending claims because the cited prior art fails the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as the independent claims are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejection under 35 U.S.C. § 103 be withdrawn.

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Withdrawn independent claims 11 and 12 have been amended similarly to claim 8 and are submitted to be patentable for at least the reasons discussed above regarding claim 8.

Accordingly, the Examiner is respectfully requested to rejoin claims 11-13.

CONCLUSION

Having fully and completely responded to the Office Action, Applicants submit that all of the claims are now in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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